

**REMARKS**

The Examiner provides a number of rejections and we list them here in the order in which they are addressed:

- I. Anticipation (35 U.S.C. § 102(b))
  - A. Claims 25 & 28-32 are allegedly anticipated under:
    - 1. United States Patent No.: 3,497,225 To Workman.
    - 2. United States Patent No.: 4,084,826 To Vossieck *et al.*
    - 3. United States Patent No.: 3,973,781 To Grorich.
  
- II. Obviousness (35 U.S.C. § 103(a))
  - A. Claims 25, 26 & 28-32 are allegedly rejected under United States Patent No.: 5,558,341 To McNickle *et al.*
  - B. Claim 27 is allegedly rejected under United States Patent No.: 3,497,225 To Workman in view of United States Patent No.: 5,452,771 To Blackman *et al.*
  - C. Claims 33 & 36-40 are allegedly rejected under United States Patent No.: 3,497,225 To Workman in view of United States Patent No.: 3,930,655 To Fern.
  - D. Claim 33 & 36-40 are allegedly rejected under United States Patent No.: 4,084,826 To Vossieck *et al.* and United States Patent No. 3,973,781 To Grorich in view of United States Patent No.: 3,930,655 To Fern.
  - E. Claims 33, 34 & 36-40 are allegedly rejected under United States Patent No.: 5,558,341 To McNickle *et al.* in view of United States Patent No.: 3,930,655 To Fern.
  - F. Claim 35 is allegedly rejected under United States Patent No.: 5,558,341 To McNickle *et al.* in view of United States Patent No.: 3,930,655 To Fern, and further in view of United States Patent No.: 5,452,771 To Blackman *et al.*

**I. The Claims Are Not Anticipated**

The Examiner has rejected Claims 25 & 28-32 under 35 U.S.C. § 102(b) as being allegedly anticipated by Workman, Vossieck *et al.* or Grorich. For the reasons set forth hereafter, the Applicants assert that these references do not anticipate the indicated claims.

As the Examiner is well aware, a single reference must disclose each limitation of a claim in order for that reference to anticipate the claim. *Atlas Powder Co. v. E.I. du Pont De Nemours & Co.*, 224 U.S.P.Q. 409, 411 (Fed. Cir. 1984). This criterion is not met with the above cited references.

**A. Workman Does Not Anticipate Claims 25 & 28-32**

The Examiner states that Workman "compris[es] an outer peripheral edge 28 ...". *Office Action*, pg. 2. The Applicants disagree. The Examiner has misunderstood Workman's invention and redefined Workman's elements. In contrast to the Examiner's conclusion, Workman actually teaches that "Cantilever rim 28 is the **inner edge** of the seal molding ..." *col 3, ln 10-11* [emphasis added]. Consequently, Workman does not teach any protrusions interior to the outer peripheral edge.<sup>1</sup>

The Examiner admits that Workman's protrusions are identified as elements 43, 45 and 47. These elements, however, are explicitly associated with dynamic sealing element 16:

"... the dynamic sealing element 16 has ... embossed lands ... 43, 45, and 47" ... [and] extend completely across dynamic sealing element 16. *col 3 ln 44-55* [emphasis added]. Further, Workman expressly places dynamic sealing element 16 away from the real outer peripheral edge (*i.e.*, flange 18):

... an outer static and dynamic sealing element generally designated 22, **between** flange 18 and dynamic sealing element 16 ... *Workman, col. 2 ln 62-64* [emphasis added]. Workman teaches that the dynamic sealing element 16 is completely covered by the embossed lands (43, 45, and 47) and the lands are not limited in location to one edge or the other (*i.e.*, for example, the outer peripheral edge; flange 18) Consequently, the Workman cannot anticipate the Applicants' claimed embodiment comprising protrusions interior to the outer peripheral edge.

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<sup>1</sup> The Examiner's error also rebuts anticipation of Claim 32 (See ¶ 3e)

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 25 to recite an outer peripheral edge "wherein said edge is raised"<sup>2</sup> and "circumferentially located" protrusions. These amendments are made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants now respectfully request the Examiner withdraw this rejection.

**B. Vossieck *et al.* And Grorich Do Not Anticipate Claims 25 & 28-32.**

The Examiner offers Vossieck *et al.* and Grorich in a highly conclusory manner by stating only that Claims 25, 28-32 are "clearly anticipated". *Office Action* pg 3 ¶ 4. Consequently, the Examiner has provided no evidence and no explanation as to how Vossieck *et al.* and Grorich allegedly anticipate the claims. The Applicants are (inappropriately) left TO GUESS at the Examiner's rationale.

The Applicants argue that Vossieck *et al.* and Grorich do not teach the Applicants' embodiments as claimed. The present rejection, however, is moot due to the above claim amendments.

The Applicants now respectfully request the Examiner withdraw this rejection.

**II. The Claims Are Not *Prima Facie* Obvious**

The Examiner asserts six independent obviousness rejections totaling six references. (*supra*). The Applicants point out that the "piling on" of references in order to "pick & choose" elements from otherwise unrelated publications is not permitted under Federal Circuit case law:

It is impermissible, within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.

*In re Hedges*, 228 USPQ 685, 687 (Fed. Cir. 1986)(citing *In re Wesslau*, 353 F.2d 238, 241, 147 USPQ 391, 393 (CCPA 1965). In fact, the Federal Circuit considers using many references in an attempt to establish obviousness as indicating non-obviousness. The

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<sup>2</sup> Clearly shown in Applicants' Figure 5.

Applicants believe the Examiner is "picking & choosing" from the cited references because when viewed as a whole, the Applicants' claimed embodiment is not *prima facie* obvious.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the reference(s) themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *In re Vaeck*, 947 F.2d 488, 20 USPQ.2d 1438 (Fed. Cir. 1991); and *MPEP* § 2142; Establishing A *Prima Facie* Case Of Obviousness. The Examiner is reminded that if ONLY ONE of the above requirements is not met, then a *prima facie* case of obviousness does not exist. The Applicants submit that the Examiner's rejection does not meet these criterion. The Applicants rebut the establishment of a *prima facie* case of obviousness by the argument below.

**A. McNickle *et al.* Is Not A Proper Primary Reference**

The Examiner asserts McNickle *et al.*: i) as a single reference to reject Claims 25, 26 & 28-32 ; ii) in combination with Fern to reject Claims 33, 34 & 36-40; and iii) in combination with Fern and Blackman to reject Claim 35. The Applicants disagree.

Nonetheless, the Applicants choose to maintain consistency between Claim 25 and Claim 33 by incorporating the claim amendments made to Claim 25 into Claim 33. The Examiner knows that McNickle *et al.* does not teach "circumferentially located" protrusions interior to an outer peripheral edge having a raised edge. On the contrary, Figure 6 within McNickle *et al.* clearly show that the "elongated pads" are equally spaced over the entire sealing surface 42 and a smooth outer peripheral edge. These amendments are made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

Nothing in Fern or Blackman teach these missing elements. As such, a *prima facie* case of obviousness fails because McNickle *et al.*, Fern and Blackman do not teach all the elements of the Applicants' claimed embodiment.

The Applicants respectfully request the Examiner withdraw this rejection.

**B. Claim 27 Is Not Obvious Under Workman In View Of Blackman**

The Applicants point out that this rejection cannot stand because Claim 25 (as amended above) is patentable. Further, Blackman is properly classified as non-analogous art

by teaching a cutting blade and not a seal. Therefore, combining Workman with Blackman fails as a proper 35 USC § 103 rejection.

**C. Claims 33 & 36-40 Are Not Obvious Under Workman In View Of Fern  
And Further In View Of Blackman**

The Applicants have argued the deficiencies of Workman in Section I above and will not repeat them here. The Examiner should realize that when the Applicants' embodiment is viewed as a whole, one advantage keeps abrasive particles away from the seal. Neither Workman, Fern nor Blackman<sup>3</sup> teach any reasonable expectation of success regarding this advantage.

Nonetheless, without acquiescing to the Examiner's argument but to further the prosecution, and hereby expressly reserving the right to prosecute the original (or similar) claims, Applicants have amended Claim 33 (and Claim 25 to maintain consistency) to recite that the seal is produced "by creating a region of intensified contact" with concomitant cancellation of Claims 32 and 40. This amendment is made not to acquiesce to the Examiner's argument but only to further the Applicants' business interests, better define one embodiment and expedite the prosecution of this application.

The Applicants now respectfully request the Examiner withdraw this rejection.

**D. Claim 33 & 36-40 Not Obvious Under Vossieck *et al.* In View Of Grorich  
In Further View Of Fern.**

The Applicants find this rejection moot under the above described claim amendments. Specifically, this combination of cited references does not teach a raised outer peripheral edge having circumferentially located protrusions creating a region of intensified contact. Further, even if the Examiner asserts this combination of elements is present (which it is not) these references do not teach any reasonable expectation of success that abrasive particles would be kept away from the seal.

**CONCLUSION**

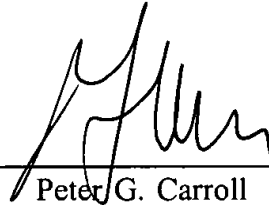
The Applicants believe that the arguments and claim amendments set forth above traverse the Examiner's rejections and, therefore, request that all grounds for rejection be

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<sup>3</sup> Blackman (even though not relevant) TEACHES AWAY from the Applicants' claimed embodiment by teaching that the cutting blade comes into contact with dirt and debris for the purpose of drilling.

withdrawn for the reasons set above. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, the Applicants encourage the Examiner to call the undersigned collect at 617.984.0616.

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